

REMARKS

After entry of this Amendment, the pending claims are: claims 1, 3-10, 15, 16, 20-32, 34-51, 55-66 and 71-76. The Office Action dated November 26, 2007 has been carefully considered. Claims 2, 11-13, and 67-70 have been canceled without prejudice. Claims 14, 17-19, 33, and 52-54 were previously canceled. Claims 1, 16, and 66 have been amended. Claims 3-10, 15, 25-27, 29-32, 34-40, 43, 49-51, 56-58, 61-65, 75, and 76 have been amended without prejudice to correct grammatical errors. No new matter has been added. Reconsideration and allowance of the present application in view of the above Amendments and the following Remarks is respectfully requested.

In the Office Action dated November 26, 2007, the Examiner:

- withdrew the allowability of claims 14, 19, 20, 38, 43, 44 51, and 55-76 in view of United States Published Patent Application No. 2002/0139423 to Roethel (“Roethel”);
- rejected claims 1-13, 15, and 21-26 under 35 U.S.C. 112 , first paragraph, as failing to comply with the written description requirement;
- rejected claims 69 and 70 under 35 U.S.C. 112 , first paragraph, as failing to comply with the written description requirement;
- rejected claims 1-12, 15, 21-23, 27-32, 34-36, 39-41 and 45-47 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,660,006 to Markworth *et al.* (“Markworth”);
- rejected claims 1 and 11 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,440,133 to Beale *et al.* (“Beale”);
- rejected claims 24-26 and 48-50 under 35 U.S.C. 103(a) as being unpatentable over Markworth in view of U.S. Patent No. 5,688,274 to Errico *et al.* (“Errico”);

- rejected claims 38 and 65-70 under 35 U.S.C. 103(a) as being unpatentable over Markworth in view of Roethel;
- rejected claims 12, 13, 16, 20, 27, 35-37, 40-44, 51, 55-64 and 71 under 35 U.S.C. 103(a) as being unpatentable over Beale in view of Roethel; and
- rejected claims 72-74 under 35 U.S.C. 103(a) as being unpatentable over Beale in view of Roethel and in further view of Markworth and Errico.

35 U.S.C. 112 , FIRST PARAGRAPH

Independent claim 1 has been rejected under 35 U.S.C. 112 , first paragraph, for failing to comply with the written description requirement. Specifically, independent claim 1 was rejected for reciting the limitation “the first and second tips being sized and configured to slide onto ...” In particular, the Examiner rejected the use of the term “slide.” In order to expedite prosecution of the present application, independent claim 1 has been amended to recite “wherein the actuating member includes a first tip and a second tip, the first tip engaging the at least one slot formed on the proximal end of the holder assembly and the second tip engaging the first pair of slots formed on the proximal end of the tubular member.” As such this rejection is believed to be moot. Withdrawal of this rejection and allowance of independent claim 1 is specifically requested.

In addition, dependent claim 69 has been rejected under 35 U.S.C. 112 , first paragraph, for failing to comply with the written description requirement. Specifically, dependent claim 69 was rejected for reciting “further include a tip sized and configured to snap onto...” In order to expedite

prosecution of the present application, dependent claim 69 has been canceled. As such this rejection is believed to be moot. Withdrawal of this rejection is specifically requested.

Dependent claim 70 has been rejected for being dependent upon a non-enabled claim.

Dependent claim 70 has been canceled. As such this rejection is believed to be moot. Withdrawal of this rejection is specifically requested.

INDEPENDENT CLAIM 1

Independent claim 1 has been rejected as being anticipated by Markworth. Moreover, independent claim 1 has also been rejected as being anticipated by Beale.

As amended, independent claim 1 recites, *inter alia*, a surgical instrument comprising a holder assembly including a proximal end and a distal end, the distal end including a pair of fingers for engaging a spinal implant, the proximal end including at least one slot; a release assembly; and an actuating member operatively associated with the holder assembly and the release assembly; wherein the release assembly comprises a tubular member and a pusher member, the tubular member being slidably disposed within the holder assembly, and the pusher member slidably surrounding at least a portion of the holder assembly, the tubular member including a proximal end and a distal end, the proximal end of the tubular member including a first pair of slots and a second pair of slots; and wherein the actuating member includes a first tip and a second tip, the first tip engaging the at least one slot formed on the proximal end of the holder assembly and the second tip engaging the first pair of slots formed on the

proximal end of the tubular member and the second pair of slots aligning with the at least one slot formed on the holder assembly when the release assembly is inserted into the holder assembly.

Markworth discloses a body 200, a slide 300, a sleeve 400 and a trigger 500 wherein the trigger 500 connects the slide 300 to the body 200. The trigger 500 includes a plurality of lower holes 508 which are generally aligned with threaded holes 220 formed in the body 200 and a plurality of upper holes 506 which are generally aligned with threaded holes 306 formed in the slide 300. Screws 106 secure the trigger 500 to the body 200 while screws 108 secure the trigger 500 to the slide 300.

It is respectfully submitted that Markworth does not disclose, teach, or suggest a holder assembly wherein the proximal end of the holder assembly includes at least one slot; a release assembly wherein the release assembly comprises a tubular member and a pusher member, the tubular member including a first pair of slots and a second pair of slots, the second pair of slots aligning with the at least one slot formed on the holder assembly when the release assembly is inserted into the holder assembly; and an actuating member including a first tip and a second tip, the first tip engaging the at least one slot formed on the proximal end of the holder assembly and the second tip engaging the first pair of slots formed on the proximal end of the tubular member. Rather, Markworth discloses a trigger that threadably engages a body and a slide, thus it is respectfully submitted that Markworth does not disclose, teach or suggest all of the limitations of independent claim 1. Withdrawal of this rejection and allowance of independent claim 1 is respectfully requested.

Moreover, independent claim 1 has been rejected as being anticipated by Beale. It is respectfully submitted that Beale also does not disclose, teach, or suggest a holder assembly wherein the proximal

end of the holder assembly includes at least one slot; a release assembly wherein the release assembly comprises a tubular member and a pusher member, the tubular member including a first pair of slots and a second pair of slots, the second pair of slots aligning with the at least one slot formed on the holder assembly when the release assembly is inserted into the holder assembly; and an actuating member including a first tip and a second tip, the first tip engaging the at least one slot formed on the proximal end of the holder assembly and the second tip engaging the first pair of slots formed on the proximal end of the tubular member. Rather, Beale discloses a fastener engaging member 80 and a reducing member 100 coupled together by an actuator assembly 51 wherein the actuator assembly 51 is pivotally coupled to the fastener engaging member 80 via a pin 99 and is pivotally coupled to the reducing member 100 via pivot pins 118. Thus it is respectfully submitted that Beale does not disclose, teach or suggest all of the limitations of independent claim 1. Withdrawal of this rejection and allowance of independent claim 1 is respectfully requested.

For at least the above-identified reasons, it is respectfully submitted that neither Markworth or Beale disclose, teach or suggest all of the limitations of independent claim 1. Thus, it is respectfully submitted that independent claim 1 is allowable over the cited prior art. Withdrawal of these rejections and allowance of independent claim 1 is respectfully requested.

Furthermore, as claims 3-10, 15, and 21-26 all depend from independent claim 1, it is submitted that these claims are equally allowable for at least the reason identified above. Withdrawal of these rejections and allowance of claims 2-10, 15, and 21-26 is also respectfully requested.

INDEPENDENT CLAIM 16

Independent claim 16 has been rejected as being unpatentable over Beale in view of Roethel. As amended, independent claim 16 recites, *inter alia*, a surgical instrument comprising a holder assembly including a proximal end and a distal end, the distal end including a pair of diametrically opposed slots defining a pair of fingers for engaging a spinal implant; a release assembly including a tubular member and a pusher member, the tubular member slidably disposed within the holder assembly, and the pusher member slidably surrounding at least a portion of the holder assembly; wherein the tubular member and the pusher member each comprise a proximal end and a distal end, the distal end of the tubular member includes at least one hole and the pusher member includes at least one aperture, the at least one hole and the at least one aperture receiving at least one pin for securing the pusher member to the tubular member, the pin being displaceable within the pair of diametrically opposed slots formed in the holding assembly.

It is respectfully submitted that Beale does not disclose teach or suggest a holder assembly including a pair of diametrically opposed slots defining a pair of fingers and a release assembly including a tubular member and a pusher member, the tubular member slidably disposed within the holder assembly, and the pusher member slidably surrounding at least a portion of the holder assembly; wherein the distal end of the tubular member includes at least one hole and the pusher member includes at least one aperture, the at least one hole and the at least one aperture receiving at least one pin for securing the pusher member to the tubular member, the pin being displaceable within the pair of diametrically opposed slots formed in the holding assembly. Rather, Beale discloses a fastener engaging

member 80 and a reducing member 100 wherein the reducing member 100 slidably surrounds the fastener engaging member 80.

It is respectfully submitted that there is absolutely no disclosure, teaching or suggestion in Beale of providing a two piece release assembly (*e.g.*, tubular member and pusher member) wherein the tubular member is slidably disposed within the holder assembly, and the pusher member is slidably surrounding at least a portion of the holder assembly.

Moreover, it is respectfully submitted that there is absolutely no disclosure, teaching or suggestion in Beale of the distal end of the tubular member including at least one hole and the pusher member including at least one aperture for receiving at least one pin for securing the pusher member to the tubular member wherein the pin is located and displaceable within a pair of diametrically opposed slots formed in the holding assembly. Thus it is respectfully submitted that Beale does not disclose, teach or suggest all of the limitations of independent claim 16.

It is respectfully submitted that Roethel does not overcome the short comings of Beale. Roethel was cited for the proposition that it would be obvious for one of ordinary skill in the art to incorporate a friction fit, a snap fit, a threaded connection, adhesive, *etc.* in place of the pivot pins disclosed in Beale. Without addressing the merits of this argument, it is respectfully submitted that, for at least the above-identified reasons, neither Beale or Roethel, either alone or in combination, disclose, teach or suggest all of the limitations of independent claim 16. Thus, it is respectfully submitted that independent claim 16 is allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 16 is respectfully requested.

Furthermore, as claim 20 depends from independent claim 16, it is submitted that claim 20 is equally allowable for at least the reasons identified above. Withdrawal of this rejection and allowance of claim 20 is also respectfully requested.

INDEPENDENT CLAIMS 27 AND 40

Independent claims 27 and 40 were rejected as being anticipated by Markworth. Moreover, independent claims 27 and 40 were rejected as being anticipated by Beale in view of Roethel.

Independent claims 27 and 40 both recite, *inter alia*, a surgical instrument comprising a holder assembly having a proximal end and a distal end, the distal end including an elongated slot and a pair of fingers; a release assembly comprising a tubular member and a pusher member, the tubular member slidably disposed within the holder assembly, and the pusher member slidably surrounding at least a portion of the holder assembly; wherein the tubular member and the pusher member each comprise a proximal end and a distal end, the distal end of the tubular member includes at least one hole and the pusher member includes at least one aperture, the at least one hole and the at least one aperture receiving at least one pin for securing the pusher member to the tubular member, the pin being displaceable within the elongated slot of holding assembly.

It is respectfully submitted that neither Markworth or Beale disclose, teach or suggest a holder assembly including an elongated slot and a pair of fingers, and a release assembly including a tubular member and a pusher member, the tubular member slidably disposed within the holder assembly, and the pusher member slidably surrounding at least a portion of the holder assembly.

Moreover, it is respectfully submitted that neither Markworth or Beale disclose, teach or suggest that the distal end of the tubular member includes at least one hole and the pusher member includes at least one aperture, the at least one hole and the at least one aperture receiving at least one pin for securing the pusher member to the tubular member, the pin being displaceable within the elongated slot of holding assembly.

It is respectfully submitted that there is absolutely no disclosure, teaching or suggestion in Markworth or Beale of providing a two piece release assembly (*e.g.*, tubular member and pusher member) wherein the tubular member is slidably disposed within a holder assembly, and the pusher member is slidably surrounding at least a portion of the holder assembly, the distal end of the tubular member including at least one hole and the pusher member including at least one aperture for receiving at least one pin for securing the pusher member to the tubular member wherein the pin is located and displaceable within the elongated slot of holding assembly. Thus it is respectfully submitted that neither Markworth or Beale disclose, teach or suggest all of the limitations of independent claims 27 and 40.

Moreover, it is respectfully submitted that Roethel does not overcome the short comings of Beale. Roethel was cited for the proposition that it would be obvious for one of ordinary skill in the art to incorporate a friction fit, a snap fit, a threaded connection, adhesive, *etc.* in place of the pivot pins disclosed in Beale. Without addressing the merits of this argument, it is respectfully submitted that, for at least the above-identified reasons, neither Beale or Roethel, either alone or in combination, disclose, teach or suggest all of the limitations of independent claims 27 and 40. Thus, it is respectfully submitted

that independent claims 27 and 40 are allowable over the cited prior art. Withdrawal of these rejections and allowance of independent claims 27 and 40 is respectfully requested.

Furthermore, as claims 28-32, 34-39, and 45-50 all depend from independent claim 27 and, as claims 41-44 all dependent from independent claim 40, it is submitted that these claims are equally allowable for at least the reasons identified above. Withdrawal of these rejections and allowance of claims 28-32, 34-39, and 41-50 is also respectfully requested.

INDEPENDENT CLAIM 51

Independent claim 51 was rejected as being unpatentable over Beale in view of Roethel. Independent claim 51 recites, *inter alia*, a surgical instrument comprising a holder assembly having a proximal end and a distal end; a release assembly having a proximal end and a distal end; and a hand grip having a first tip and a second tip to snap onto and engage the proximal end of the holder and release assemblies, respectively, wherein the proximal end of the holder assembly includes at least one slot to receive a portion of the hand grip; the proximal end of the release assembly includes a first pair of slots to receive a portion of the hand grip; and the proximal end of the release assembly further includes a second pair of slots corresponding with the slots formed on the holder assembly when the release assembly is inserted into the holder assembly.

It is the Examiner's position, that it would have been obvious to one of ordinary skill in the art to combine the connection in Roethel with Beale to arrive at the invention of independent claim 51. As an initial matter, it is respectfully submitted that the Examiner has not identified any reason why a person

of ordinary skill in the art would combined Beale with Roethel other than it would teach all of the elements of independent claim 51. (*See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. _____ (2007) “[a] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently known, in the prior art ... important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.”)

Moreover, it is respectfully submitted that Roethel is directed to a fluid valve for connecting a first component to a second component. Roethel discloses that the first component can be coupled to the second component by any means including a friction-fit, a snap-fit, a threaded connection, adhesive, *etc.* It is respectfully submitted that one of ordinary skill in the art would not look to Roethel in order to modify Beale to incorporate a snap-fit connection.

Furthermore, even if the combination of Beale and Roethel was proper, which in our opinion and judgment it is not, the combination still would not disclose, teach or suggest all of the limitations of independent claim 51. In particular, the combination of Beale and Roethel still does not disclose, teach or suggest providing at least one slot formed on the proximal end of the holder assembly to receive a portion of the hand grip; and first and second pairs of slots formed on the proximal end of the release assembly wherein the first pair of slots receives a portion of the hand grip and the second pair of slots corresponds with the slots formed on the holder assembly when the release assembly is inserted into the holder assembly.

Thus, it is respectfully submitted that neither Beale or Roethel, either alone or in combination, disclose, teach or suggest all of the limitations of independent claim 51. Withdrawal of this rejection and allowance of independent claim 51 is respectfully requested.

Furthermore, as claims 55-64 and 71-76 all depend from independent claim 51, it is submitted that these claims are equally allowable for at least this reason. Withdrawal of these rejections and allowance of claims 55-64 and 71-76 is also respectfully requested.

INDEPENDENT CLAIM 65

Independent claim 65 was rejected as being unpatentable over Markworth in view of Roethel. Independent claim 65 recites, *inter alia*, a surgical instrument comprising a holder assembly having a proximal end and a distal end; a release assembly having a proximal end and a distal end; and a hand grip, wherein the proximal end of the release assembly includes a slot to mate with an alignment pin in the proximal end of the holder assembly to facilitate proper alignment of the release assembly within the holder assembly.

It is respectfully submitted that the Examiner has withdrawn his allowance of independent claim 65 in view of Roethel. Roethel was cited for the proposition that it would be obvious for one of ordinary skill in the art to incorporate a friction fit, a snap fit, a threaded connection, adhesive, *etc.* in place of the connection disclosed in Markworth. It is respectfully submitted that neither Markworth or Roethel, either alone or in combination, disclose, teach or suggest a holder assembly and a release assembly wherein a proximal end of the release assembly includes a slot to mate with an alignment pin in a

proximal end of the holder assembly to facilitate proper alignment of the release assembly within the holder assembly.

Thus, it is respectfully submitted that neither Markworth or Roethel, either alone or in combination, disclose, teach or suggest all of the limitations of independent claim 65. Withdrawal of this rejection and allowance of independent claim 65 is respectfully requested.

INDEPENDENT CLAIM 66

Independent claim 66 was rejected as being unpatentable over Markworth in view of Roethel. Independent claim 66 recites, *inter alia*, a surgical instrument comprising a holder assembly having a proximal end and a distal end; a release assembly having a proximal end and a distal end; and a hand grip having a first tip and a second tip to snap onto and engage the proximal end of the holder and release assemblies, respectively, wherein the hand grip includes a first grip member, a second grip member, a first jaw member, and a second jaw member, the first grip member pivotally coupled to the second grip member, and the first and second jaw members are operatively associated with the holder and release assemblies, respectively; wherein the first grip member is pivotally coupled to the first jaw member and the second grip member is pivotally coupled to the second jaw member; and wherein the first grip member further includes a pin slidably movable in a slot formed in the second jaw member and the second grip member includes a pin slidably movable in a slot formed in the first jaw member to maintain the jaw members in parallel alignment when the instrument is actuated; and wherein when the hand grip snaps onto the holder and release assemblies, the hand grip is orientated substantially perpendicular to the longitudinal axes of the holder and release assemblies.

It is respectfully submitted that neither Markworth or Roethel, either alone or in combination, disclose, teach or suggest a hand grip wherein the hand grip includes a first grip member, a second grip member, a first jaw member, and a second jaw member, the first grip member pivotally coupled to the second grip member, wherein the first grip member is pivotally coupled to the first jaw member and the second grip member is pivotally coupled to the second jaw member; and wherein the first grip member further includes a pin slidably movable in a slot formed in the second jaw member and the second grip member includes a pin slidably movable in a slot formed in the first jaw member to maintain the jaw members in parallel alignment when the instrument is actuated; and wherein when the hand grip snaps onto the holder and release assemblies, the hand grip is orientated substantially perpendicular to the longitudinal axes of the holder and release assemblies.

Thus, it is respectfully submitted that neither Markworth or Roethel, either alone or in combination, disclose, teach or suggest all of the limitations of independent claim 66. Withdrawal of this rejection and allowance of independent claim 66 is respectfully requested.

CONCLUSION

No fee is believed due for this submission. If, however, the Commissioner determines otherwise, the Commissioner is authorized to charge any fees which may now or hereafter be due in this application to Deposit Account No. 19-4709.

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In the event that there are any questions, or should additional information be required, please contact Applicants' attorney at the number listed below.

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Respectfully submitted,

/Giuseppe Molaro/
Giuseppe Molaro
Registration No. 52,039

For: Brian M. Rothery
Registration No. 35,340

Attorney for Applicants
Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, New York 10038
(212) 806-6114